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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/818,953

03/28/2001

Paul Alan Stirpe

003433.00003

9620

22907 7590 11/13/2008

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EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/818,953	<b>Applicant(s)</b> STIRPE ET AL.	
	<b>Examiner</b> Traci L. Casler	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56 and 60-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-17, 20-30, 32-39, 42-46, 48-51, 53-56 and 60-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to papers filed on October 29, 2007.

Claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-56, and 60-73 are pending.

Claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-56, and 60-73 are rejected.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-56, and 60-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are directed towards the limitation of "weighted second node indicating a user interest". The disclosure fails to teach how one would know how to weight the nodes furthermore, how are they weighted with respect to the users interest as well as how it corresponds to the first node. One of ordinary skill in the art would not be able to make and/or use the invention as disclose to obtain repeatable results.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

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thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. As to claims 20-25 in order for a method/process claim to fall within statutory subject matter the claims be tied to either a machine or transformation. A two-branched inquiry is used to show that a claim is statutory by either tying it to a particular machine or by showing that the claim transforms an article. The use of a specific machine or transformation of an article must impose **"meaningful limits"** on the claims' scope to impart patent-eligibility. The involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity, such as storing, gathering, displaying, sending and receiving of data as this does not impart a significant impact in the solution to the process but be clearly and positively claimed as to what aspect of the problem solving the machine is involved. See *in re Bilski*.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2-4, 6-17, 20-23, 25-31, 32-39, 42-46, 48-51, 53, 55-56, 60-67 and 68-73 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,151,584 Papierniak et al; Computer Architecture and Method for Validating and Collecting and metadata and data about the internet and electronic commerce environments (data Discovery). Hereinafter referred to as Papierniak. in view of US Patent 6317722, Jacobi et al; Use of electronic Shopping Carts to Generate personal recommendations. Hereinafter referred to as Jacobi.

8. As to claims 25, 34, 42, 48, 55 system and method providing personalized content to a user comprising of storage, categorizing and grouped according to relatedness and analysis of data. *Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions. (C.3 l. 20-25) as well as the inter-relationship characterization of data(C. 16 l. 35-40)(one to one; one to many etc).****Papierniak fails to teach “each weighted second node corresponding to one of the first nodes of ontology, each weighted second node indicating a degree to which the user is interested in the concept of the corresponding first node of***

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**ontology. However, Jacobi teaches weighting a known item of interest corresponding to similar items on the list and how they are weighted.(C. 6 I. 40-50 and C. 11 I. 38-38). It would have been obvious to one skilled in the art at the time of invention to combine the known technique of weighting user interest against similar items to known method ready for improvement to yield predictable results.**

9. As to claims 2-4, **the data in the warehouse...usually subject-oriented such as customer, product, activity.** (C. 14 I. 55-58)

10. As to claims 28 and 37 **formatted file library provides the intermediate classifications such as process characterizations, customer preferences, preference determination and behavior patterns.** (C. 18 I. 45-48)

As to claims 6, 32-33, 43, 49 and 56, **websmart is intend to provide the best possible knowledge for customers.** (C.18 I. 6-7)

11. As to claims 7, 9-10, 26-27 and 35-36 **a display for displaying information to a computer user.** (C. 10 I. 45-46, Fig. 4 Ref. 12)

12. As to claim 8 **involves parsing, categorizing, indexing and formatting the collected data and classifications based on preference determination used in a the technical process.** (C. 13 I. 17-18 and C. 18 I. 47-50)

13. As to claims 11, 29 and 38 **to collect data which indicates where a user has been in prior sessions.** (C. 2 I. 65-66)

14. As to claim 12, **Source data** (Sheet 13 Fig. 13, bottom left corner)

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15. As to claim 13 **visitor profile data...depends on how much information the visited applications can entice the visitor to provide.** (C. 15I. 47-49)

16. As to claim 14, **data mining tools enable the present invention to discover hidden knowledge from existing data and information.** (18 I, 65-67)

17. As to claim 15, **wherein the multiple client browsers or clients are capable of accessing a server or web server storing information.** (C.26 I.49-50)

18. As to claims 16 and 17 **results used by user for decisions(C. 3 I. 24-27) and results given to businesses about their customers to gain insight.**(C. 3I. 36-40).

19. As to claim 20 **providing customers with recommendations from information that was analyzed in clustering or artificial intelligence.**(C. 13 I. 27-29)

20. As to claims 30, 39, 50 and 53, **web warehouse is preferably time-stamped and associated with a defined period...subject oriented such as customer, product, activity and characterizing resources based on different criteria.** (C14. 56-61 and C. 16 I.35-45)

21. As to claims 21-23 **metadata defines the data views necessary to produce the outputs required for decision support.** (C. 15 I. 54-56)

22. As to claims 44-46, as best understood by the examiner, **deletion of data in the web warehouse in an appropriate time.** (C. 15 I. 65-67)

23. As to claims 60-61 Papierniak teaches **a display for displaying information to a computer user.** (C. 10 I. 45-46, Fig. 4 Ref. 12). Although Papierniak does not explicitly teach they information displayed as articles and advertisement these differences are only found in the nonfunctional descriptive material and are not

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functionally involved in the steps recited. The steps would be performed regardless of the type of information presented. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir.

24. As to claims 62 a system and method providing personalized content to a user comprising of storage, categorizing and grouped according to relatedness and analysis of data. ***Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions.*** (C.3 I. 20-25) , ***websmart is intend to provide the best possible knowledge for customers.*** (C.18 I. 6-7) ***a display for displaying information to a computer user.*** (C. 10 I. 45-46, Fig. 4 Ref. 12) ***involves parsing, categorizing, indexing and formatting the collected data.*** (C. 13 I. 17-18) ***Papierniak teaches a method of “incremental” data sources responsive to the decision support.(C23 I.62-65) as well as the inter-relationship characterization of data(C. 16 I. 35-40)***

25. As to claims 63-67 ***identifies many relationships and different levels of relationships between data.***(C. 16 I. 34-40 and Fig. 15-Fig. 16)

26. As to claims 68-73 Papiernaik teaches extracted data is refined and translated before correlating it with operational data. (C. 4 I. 53-55). Papiernaik tags to data as according to the business context but gives it no weighting.



***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 24, 51, 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak et al and Jacobi et al as applied to above, and further in view of Financialengines.com( any linkage Oct. 12, 1999).

29. As to Claim 24, Papierniak and Smith fail to teach a display method for the of what the gathered information means. Financialengines.com teaches ***how your decisions and advisor fund recommendations affect your future.***(P. 7 l. 4-7) See also Pg. 6 Fig. 2. It would have been obvious to one skilled in the art to incorporate the display method of financialengines.com to allow to the customer to see where they fit into the financial picture.

30. As to claims 51, 54 and 59, Papierniak and Smith fail to teach comparison method, financialengines.com teaches a ***retirement income projection is compared to your goal on a scenario by scenario basis.*** (Pg. 17 l.6-7) It would have been obvious to one skilled in the art to incorporate the teachings of comparison into

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Papierniak so as to allow the customer the ability to make an accurate decision of one product over another.

***Response to Arguments***

31. As to applicants rejections regarding 35 USC 101 the rejection has been withdrawn.

32. Applicant's arguments with respect to claims 2-4, 6-17, 20-30, 32-39, 42-46, 48-56, and 60-73 and rejections under 35 USC 103 have been considered but are moot in view of the new ground(s) of rejection.

33. Applicant's arguments filed July 24, 2008 have been fully considered but they are not persuasive respect to the rejections made under 35 USC 112 1st enablement rejection. The rejection states that as disclosed one of ordinary skill in the art would not be able to make and/or yielding a predictable result. The applicant argues two items. The first being that "various/ many" examples" are disclosed for how to make the invention with respect to "weighted nodes." The examiner notes that examples alone, do not satisfy the test of enablement. The level of predictability in the art as well as "undue" experimentation must be taken into consideration when reviewing whether or not the scope of a claim is enabled. The level of predictability in the art of making "recommendations" is not something that can be readily anticipated. One skilled in the art would not be able to readily anticipate and predict what certain changes would have on the outcome of the current scope of the claims. Second, as applicant admits there are various ways in which one could weight node via explicit/implicit choices and/or algorithms. This begs the question how would one skilled in the art know which

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"embodiment" the applicant used to obtain the outcome without doing any type of experimentation. For a claimed genus, representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if one skilled in the art (in view of level of skill, state of the art and the information in the specification) would expect the claimed genus could be used in that manner without undue experimentation. Proof of enablement will be required for other members of the claimed genus only where adequate reasons are advanced by the examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation. The examiner questions how one would know to use either one of limitless algorithms to produce a recommendation or whether they are supposed to use explicit/implicit choices of the user.

34. Additionally, the applicant agrees with examiner (pg. 15 response dates 7/24/2008 ¶4 that "the second nodes could be weighted in various ways based on a users interest....The claimed subject matter is not necessarily limited to a single way of weighting nodes and identifying user interest.". This simply supports examiner statements that there are various ways in which someone could weight the nodes and determine interests in an art(interest recommendation) does not have a high predictability leading to undue experimentation to determine how the applicant is "weighting" the nodes that are used in making interest recommendations.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/

Examiner, Art Unit 3629